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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,890	05/15/2001	Jeffrey S. Brooks	BSS 6422	1494

321 7590 09/08/2003

SENNIGER POWERS LEAVITT AND ROEDEL  
ONE METROPOLITAN SQUARE  
16TH FLOOR  
ST LOUIS, MO 63102

EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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## Commissioner for Patents


The reply filed on August 19, 2003 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicant's reply fail to comply with 37 CFR 1.111(b) because the reply must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office action.. The reply must specifically point how the language of the claims patentably distinguish them from the references. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Applicant fails to indicate which claims read on the elected embodiment (figures 11-12).

Applicant fails to specifically point out support for the new claims. For example, where is support for "no midsole", etc.

When substantive changes, e.g., changed obviating double patenting, indefinite language and prior art rejections, are made to the claims by the applicant, there is presumably a good reason why the changes advance the prosecution of the case. The present rule under 37 C.F.R. 1.111(b)(c) places a strong burden requiring the applicant to ensure these reasons are made clear to the examiner and to allow one reading the file history at a later date to not have to speculate as to why the claims were amended and/or allowed. The PTOS believes that the present rules should be strictly interpreted to require more than merely stating "to further define and clarify the invention" as a reason pointing out how the amendment renders the claim allowable. A more detailed explanation would help to ensure the issuance of quality patents with clear and complete file histories. The recent case of Warner-Jenkinson, brings to light the importance of having a strong burden on applicants to supply complete reasons for substantive amendments in the prosecution history file. In Warner-Jenkinson, a pivotal issue involved substantive amendments to the claims where no specific reasons were given as to why they were made. Warner-Jenkinson 117 S. Ct at 1051, 41 USPQ2d at 1868. Further scrutiny of the entire prosecution history file failed to supply any reason which could be deduced for making the amendments. If the applicant had provided more complete reasons for how the amendments distinguished the claims, as would be required by a strict interpretation of the rules, the issue could have been alleviated and the litigation expedited. Thus, this case underscores the need to require the applicant to always completely point out specific reasons for each substantive amendment as provided in the rules. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

  
Ted Kavanaugh  
Primary Examiner